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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,084

01/05/2004

David Barras

ICB-0057

5607

7590

01/12/2006

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12900 Preston Road, LB-41
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EXAMINER

KAYES, SEAN PHILLIP

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,084

Applicant(s)

BARRAS ET AL.

Examiner

Sean Kayes

Art Unit

2841

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/5/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Priority***

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 01202593.8, filed 7/05/2001. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where

Art Unit: 2841

applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

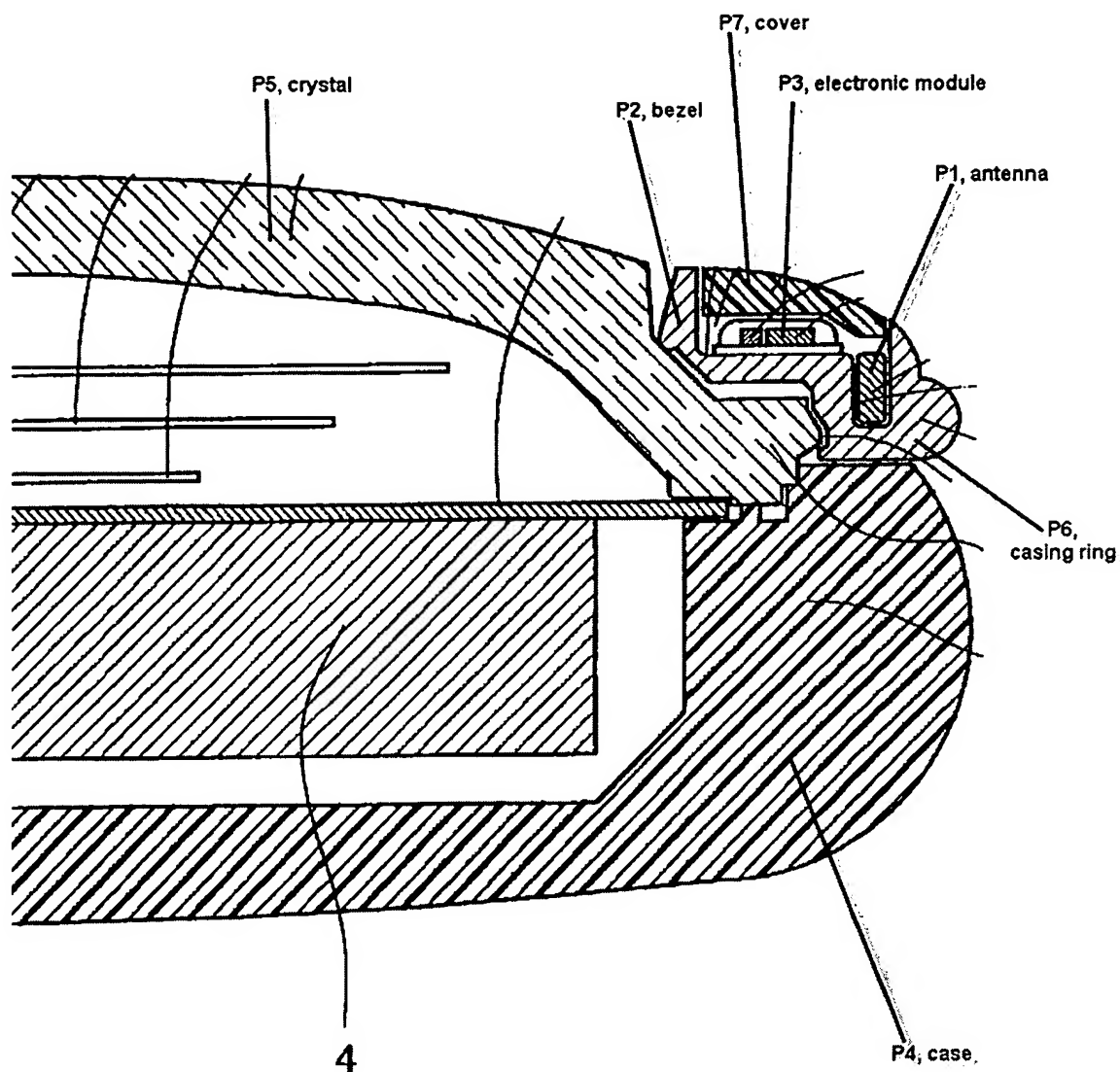
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch (US 5798984.)

4. With respect to claim 1 Koch discloses a portable electronic instrument, such as a wristwatch, including: a case enclosing an electronic module (P3, picture I.) and a display device (items 6, 8, and 10, figure 1); a crystal (P5) fitted onto said case (P4); an electric power supply (column 2 lines 52-54) source housed in said case and powering said electronic module and said display device; and an antenna (P1) for receiving and/or transmitting radio-frequency signals, the antenna (P1) being electrically connected to said electronic module (P3), wherein said case (P4) includes an exterior body including a bottom and lateral walls; and a bezel (P2) element fitted onto said exterior body, and wherein said antenna (20) rests on an outer face of said bezel element.

Art Unit: 2841

I.



5. With respect to claim 2 Koch discloses the instrument according to claim 1, wherein said bezel (P2) element is fitted in a sealed manner onto said exterior body.

Art Unit: 2841

6. With respect to claim 3 Koch discloses the instrument according to claim 1, further including casing ring (P6, picture I.) element arranged between said bezel (P2) element and said bottom, said electronic module (P3) and said display (6, 8, and 10 figure 1) device being enclosed between said bezel element and said casing ring element.

7. With respect to claim 4 Koch discloses the instrument according to claim 3, wherein said casing ring (P6 picture I.) element and said bezel (P2) element are secured to each other so as to form a sub-assembly able to be mounted on and dismantled from said exterior body.

8. With respect to claim 5 Koch discloses the instrument according to claim 3, wherein said casing ring (P6) element is held in said bottom (2) by a fixing means.

9. With respect to claim 14 Koch discloses the instrument according to claim 1, wherein said bottom and said lateral walls are made as a single part (see figure 2 item 2, or picture I. item P4.)

10. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the publication resulting from EPO application 01202593.8.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch (US 5789984.)

13. With respect to claim 6 Koch discloses the instrument according to claim 1. Koch does not disclose wherein said exterior body is made of metal material and wherein that said bezel element is made of plastic material.

At the time of the invention it would have been obvious to one skilled in the art to make the bezel out of plastic and the outer casing out of metal.

The suggestion or motivation for doing so would be to insulate the circuits attached to the bezel while providing a possible grounding point in the form of the metal casing.

14. With respect to claim 7, Koch discloses the instrument of claim 6. He does not disclose wherein an inner face of said bezel element is metallised and electrically connected to said exterior body made of metal material.

In order to connect the electronic module to the ground source as described above, it would require at least a metal wire.

Art Unit: 2841

At the time of the invention it would have been obvious to one skilled in the art to attach electronic module, located inside the bezel, to the metallic case by means of a wire. Such a wire would necessarily run along at least one face of the bezel.

The suggestion or motivation for doing so would be to ground the electronic module to the metal casing.

15. With respect to claim 8 Koch discloses the instrument according to claim 6, further including an exterior element (P6) of essentially annular shape, fitted onto said bezel (30) element, this annular-shaped exterior element having an aperture inside in which said antenna (P1) is housed. Koch does not disclose the exterior element being made of a metal material.

At the time of the invention it would have been obvious to one skilled in the art to make exterior element (P6) out of a metal material.

The suggestion or motivation for doing so would be to avoid insulating the antenna, decreasing its effectiveness.

16. With respect to claim 9 Koch discloses the instrument according to claim 1, further including a protective cover (P7) made of dielectric material fitted onto said bezel element and covering said antenna. (Koch does not disclose that the cover, P7, is made of a dielectric material. However, he does disclose that the case, P4, is constructed of plastic. Subsequently it would be reasonable to assume that Koch intends to construct cover, P7, of the dielectric material, plastic.

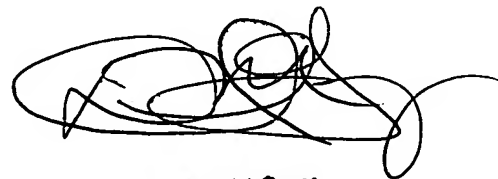
Art Unit: 2841

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Kayes whose telephone number is (571) 272-8931. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571)272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David Gray', with a large, stylized flourish extending to the right.

David Gray
Primary Examiner

SK
1/6/06